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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,370	09/30/2003	Kevin Maus	703060	4053
23460 7590 05/24/2010 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731				
EXAMINER JOHNSON, GREGORY L				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 05/24/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com

### Office Action Summary

**Application No.**

10/676,370

**Applicant(s)**

MAUS, KEVIN

**Examiner**

GREGORY JOHNSON

**Art Unit**

3691

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 70-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is in response to the amendment filed February 19, 2010.

***Status of Claims***

2. Claims 1-69 are canceled. Claims 70-84 are new and pending.

***Response to Arguments***

3. Applicant's arguments filed February 19, 2010 have been fully considered but they are not persuasive. Applicant argues, (pg. 5, re: claim 70) that McLeod fails to teach or suggest a computer-implemented method including the steps of

- (a) permitting at least one broker that is identified by the server as being licensed in the jurisdiction to place insurance policies of the type specified by the submission access through the server to the submission;
- (b) receiving, at the server, an acceptance of the submission for the insurance policy from one identified broker;
- (c) generating a quotation, by the server, for the insurance policy in the submission; and
- (d) sending, by the server, the quotation to the insurance producer.

In response to (a): McLeod teaches insurers registering on the site (i.e. iwix.net) will set guidelines for the types of business they're willing to consider, which allows iwix.net to point agents only to those underwriters (i.e. insurers) able to provide quotations.

*McLeod also teaches identifying insurers willing to write a particular risk (pg.2). And Ghosh teaches a licensing information system (LIS) which is accessed by compliance officers, insurance agents, agencies, carriers and entities requiring insurance licensing*

*and compliance services.* For instance, external systems may include sales systems which perform queries on the LIS to *verify whether certain agents may sell particular products in a given state.* Therefore, the combination of McLeod and Ghosh teach the subject matter recited in **(a)**.

In response to **(b)**, **(c)** and **(d)**, McLeod teaches the following limitations of claim 70:

- (b)** receiving, at the server, an acceptance of the submission for the insurance policy from one identified broker (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent);  
(as interpreted, delivery of quotes to the agent is implicitly teaching an acceptance of the submission);
- (c)** generating a quotation, by the server, for the insurance policy in the submission (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent); and
- (d)** sending, by the server, the quotation to the insurance producer (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent).

The Examiner maintains that the combination of McLeod and Ghosh teach the limitations as recited in claim 70.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-31 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; however, in view of the claims being canceled, the rejection is withdrawn.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 70-71, 76-78 and 80** are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas McLeod, "Web site connects insurers, agents", (hereinafter McLeod), in view of Ghosh et al., Pub. No. 2001/0032094 (hereinafter Ghosh).

**As to claim 70**, McLeod teaches a computer-implemented method comprising:

- accepting, at a server, a submission of applicant insurance data for placement of an insurance policy transmitted by an insurance producer operating in a first jurisdiction (pg.2; which discusses that agents can access the Internet Wholesale Insurance Exchanger (iwix.net) and submit specialty risks for quotations by participating insurers);
- notifying at least one identified broker about the submission (pg.2; which discusses the system e-mailing an insurer with a link to the site for viewing the (specialty risk) submission);
- permitting at least one identified broker access, through the server, to the submission (pg.2; which discusses insurers registering on the iwix.net site; and the system e-mailing an insurer with a link to the site for viewing the (specialty risk) submission);
- receiving, at the server, an acceptance of the submission for the insurance policy from one identified broker (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent);  
(as interpreted, delivery of quotes to the agent implicitly teaches the acceptance of the submission by an insurer);
- generating a quotation, by the server, for the insurance policy in the submission (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent); and

- sending, by the server, the quotation to the insurance producer (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent).

McLeod teaches insurers registering on the site (i.e. iwix.net) will set guidelines for the types of business they're willing to consider, which allows iwix.net to point agents only to those underwriters able to provide quotations. *McLeod also teaches identifying insurers willing to write a particular risk (pg.2).* However, McLeod does not explicitly teach the following limitations:

- identifying, by the server, at least one broker licensed in the first jurisdiction that accepts submissions of the type transmitted by the insurance producer searching broker data in the database; and
- providing a database containing information sufficient to identify brokers who are licensed in the first jurisdiction to place insurance policies of the type specified by the submission.

Ghosh teaches a system and method for managing licensing information in which a centralized database tracks all relevant information related to licensing of agents and agencies. The licensing information includes the states in which the agent is licensed and appointment information of the agent (e.g. insurance carriers, products authorized for sale by the carrier through the agent, etc.). Ghosh teaches that the licensing information system (LIS) can be accessed by compliance officers, insurance agents, agencies, carriers and *entities requiring insurance licensing and compliance services.* For instance, external systems may include sales systems which perform queries on the

LIS to *verify whether certain agents may sell particular products in a given state* (§§0013-0014, §0026 §0030, §0040-0041, §0047-0048, §0057 and Figs 3-4).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Ghosh within McLeod for the motivation to provide a centralized, updated and current, database that tracks all relevant information related to licensing of agents and agencies (§0013).

**As to claim 71**, McLeod teaches the following limitations:

- wherein the insurance producer is not licensed in the first jurisdiction to broker insurance policies of the type specified by the applicant insurance data (pg.2; which discusses using licensed intermediaries when an agent does hold the proper license).

**As to claims 76-77**, McLeod teaches the following limitations:

- wherein the insurance policy comprises a surplus lines insurance policy (pg.2; which discusses agents needing to hold surplus lines licenses in order to access surplus lines insurers through iwix.net);
- wherein the surplus lines insurance policy includes a property and casualty insurance policy (pg.2; which discusses iwix.net, a virtual marketplace, that will let small and medium-sized agents place specialty property/casualty coverages with surplus lines insurers);



**As to claim 78**, McLeod teaches the following limitations:

- identifies brokers with surplus lines licenses in the first jurisdiction (pg.2; which discusses insurers registering on the iwix.net site and setting guidelines for the types of business they're willing to consider, thereby allowing iwix.net to point agents only to those underwriters able to provide quotations; iwix.net *identifies the insurers* willing to write a particular risk; and agents without a surplus lines license can have his/her submissions referred through surplus lines-licensed intermediaries registered with the site).

McLeod does not explicitly disclose a "database"; however, this element is disclosed by Ghosh.

**As to claim 80**, McLeod teaches the following limitation:

- receiving by the server an acceptance of the quotation for the insurance policy from the insurance producer (pg.2; which discusses an agent sending a request to bind coverage through iwix.net).

**9. Claims 72-75** are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod and Ghosh as applied to claim 70 above, and further in view of Debber, Pub. No. 2003/0144887 (hereinafter Debber).

**As to claims 72-75**, neither McLeod nor Ghosh explicitly teach the following limitations; however, Debber teaches the limitations:

- providing a graphical user interface to the insurance producer to allow the insurance producer to enter the applicant insurance data (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106);
- wherein the graphical user interface allows the insurance producer to enter information related to an insured entity of the insurance policy (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106);
- wherein the graphical user interface is provided to the insurance producer over the internet (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106); and
- wherein the graphical user interface is configured to be displayed by an internet browser (Abstract, ¶¶0010, ¶¶0036-0039, ¶¶0052, ¶¶0066, ¶¶0092 and ¶¶0100-0106).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Debber within the combination of McLeod and Ghosh for the motivation to provide a method for electronically creating, filing and approving applications for insurance coverage (¶¶0010).

**10. Claim 79** is rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod and Ghosh as applied to claim 70 above, and further in view of Luchs et al., Pat. No. 4,831,526 (hereinafter Luchs).

**As to claim 79**, neither McLeod nor Ghosh explicitly teach the following limitation; however, Luchs teaches the limitation:

- providing a database containing information describing legal requirements for placing policies of the specific type in the first jurisdiction (Abstract, col.14, lines 35-45 and col. 21, lines 39-58; which discusses a central processor with a data bank containing the laws and regulations of various state agencies having governmental control over insurance transactions, such laws and regulations).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Luchs within the combination of McLeod and Ghosh for the motivation to provide a computerized insurance method for storing in a data bank information representing laws and regulations of individual state governments which control and regulate the various parameters of insurance contracts, in addition to look up tables which correlate information repeatedly called for on insurance policies (col.2, line 47 thru col. 3, line 4).

**11. Claims 81-84** are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod and Ghosh as applied to claims 70 and 80 above, and further in view of Jinks, Pub. No. 2002/0055862 (hereinafter Jinks).

**As to claims 81-84**, neither McLeod nor Ghosh explicitly teach the following limitations; however, Jinks teaches the limitations:

- generating the insurance policy according to regulatory requirements of the first jurisdiction related to insurance policies of the specific type

(¶0033; which discusses completing the processing of an insurance application and the issuance of an insurance policy, which includes additional information that is required by a particular state or regulatory agency);

- rating the insurance policy based on a set of guidelines (¶0015, ¶0025-0029 and ¶0039-0040; via underwriting rules and managing general agents (MGAs) providing a list of rules for each of the carriers that they represent);
- notifying an underwriter who underwrites the insurance policy when the insurance policy does not satisfy the set of guidelines (¶0015, ¶0025-0029 and ¶0039-0040; which discusses risks that cannot be automatically assessed are routed an underwriter to evaluate the risk); and
- providing a graphical user interface to the underwriter to allow the underwriter to rate the insurance policy when the insurance policy does not satisfy the set of guidelines (¶0015, ¶0025-0029 and ¶0039-0040; which discusses underwriters accessing the system to provide manual input into the risk evaluation process for risks that cannot be evaluated automatically by the interactive insurance server).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Jinks within McLeod for the motivation to provide a method for obtaining commercial insurance quotations from a variety of insurance carriers (¶0005).

***Conclusion***

**12.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **GREGORY JOHNSON** whose telephone number is (571)272-2025. The examiner can normally be reached on **Monday - Friday, 8:30AM - 5:00PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **ALEXANDER KALINOWSKI** can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON  
Examiner  
Art Unit 3691